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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

JAMES R. GLIDEWELL DENTAL CERAMICS, INC.,

Plaintiff,

vs.

KEATING DENTAL ARTS, INC.,

Defendant.

| Case No. SACV11-01309-DOC(ANx)

**JAMES R. GLIDEWELL DENTAL
CERAMICS, INC.'S NOTICE OF
MOTION AND MOTION IN LIMINE
#3 TO EXCLUDE THE PROPOSED
EXPERT TESTIMONY OF
KEATING DENTAL ARTS, INC.'S
EXPERT DR. DAVID W.
EGGLESTON; MEMORANDUM OF
POINTS AND AUTHORITIES**

Hearing

Date: January 28, 2013

Date: January 2
Time: 8:30 a.m.

Ctrm: 9D, Hon. David O. Carter

Pre-Trial Conf.: January 28, 2013
Jury Trial: February 26, 2013

1 **TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:**

2 **PLEASE TAKE NOTICE** that on January 28, 2013, at 8:30 a.m., in the
 3 courtroom of the Honorable David O. Carter of the above-entitled Court, Plaintiff
 4 and Counterdefendant James R. Glidewell Dental Ceramics, Inc. (“Glidewell”) will
 5 and hereby does move *in limine* pursuant to Federal Rule of Evidence Rules 702
 6 and 403, for an order precluding Defendant and Counterclaimant Keating Dental
 7 Arts, Inc. (“Keating”) from introducing testimony from its expert, Dr. David W.
 8 Eggleston, that the terms “Bruxzir” or “bruxer” are generic terms for certain types
 9 of dental crowns. Glidewell believes that Keating will likely proffer such testimony
 10 at trial because Dr. Eggleston made such assertions in his expert reports, in his
 11 declarations submitted in connection with the parties’ cross-motions for summary
 12 adjudication, and in his deposition. Dr. Eggleston’s assertions that the terms
 13 “Bruxzir” and its purported phonetic equivalent, “bruxer,” are generic terms for all
 14 zirconia dental crowns fails to meet the standards for admissibility under Federal
 15 Rule of Evidence 702 and under *Daubert v. Merrell Dow Pharmaceuticals, Inc.*,
 16 509 U.S. 579 (1993). For this reason the Court should exclude Dr. Eggleston’s
 17 testimony on the issue of the validity of the BruxZir mark, including that the mark
 18 is generic or descriptive without secondary meaning. Glidewell also moves *in*
 19 *limine* to exclude Dr. Eggleston from offering any opinions that were not included
 20 in his expert reports, his declarations, or his deposition, including as to likelihood of
 21 confusion between Glidewell’s registered BruxZir mark and Keating’s KDZ Bruxer
 22 mark.

23 This motion is made following the Local Rule 16-2 Meeting of Counsel
 24 Before Final Pretrial Conference and the discussion of evidentiary matters pursuant
 25 to Local Rule 16-2.6, which took place on December 19, 2012 (in-person meeting)
 26 and Local Rule 7-3 Conference of Counsel Prior to Filing of Motions, which took
 27 place on December 31, 2012 (telephonically) and continued on January 2, 2013
 28 (telephonically). The parties’ counsel discussed the issues presented by this

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1 Motion, but could not reach agreement.

2 This Motion is based upon this Notice of Motion and Motion, the
3 accompanying Memorandum of Points and Authorities and all exhibits thereto, the
4 pleadings, records, and papers on file with the Court, all matters upon which the
5 Court may take judicial notice, and such oral arguments as the Court may receive.

6 Dated: January 17, 2013

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7

8 By: *s/Greer N. Shaw*

9 Philip J. Graves
10 Greer N. Shaw
11 Deborah S. Mallgrave

12 Attorneys for Plaintiff
13 James R. Glidewell Dental Ceramics, Inc.
14 dba Glidewell Laboratories

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| 28 <i>Viterbo v. Dow Chem. Co.</i> , 29 646 F. Supp. 1420(E.D. Tex. 1986) 30 aff'd, 826 F.2d 420 (5th Cir. 1987) | 11 |
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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

The Court should exclude the testimony of Keating's expert, Dr. David W. Eggleston regarding whether Glidewell's registered trademark, "Bruxzir" – or the purportedly phonetically equivalent term, "bruxer" – are generic terms for dental crowns. The Court also should preclude Dr. Eggleston from offering any new opinions that were not previously included in his expert reports, including any opinions or testimony regarding likelihood of confusion between Glidewell's "BruxZir" mark and Keating's "KDZ Bruxer" mark.

Glidewell contends that Keating's use of "KDZ Bruxer" infringes Glidewell's trademark for "BruxZir," which is registered in connection with dental restoration products, such as crowns and bridges. Keating contends that Glidewell's "BruxZir" mark is a generic term for such products. "The crucial date for the determination of genericness is the date on which the alleged infringer entered the market with the disputed mark or term." *Yellow Cab Co. of Sacramento v. Yellow Cab Co. of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005). Here, Keating admits that it "adopted and began using" its KDZ Bruxer mark "[i]n approximately April 2011." (Dkt. #67 at 13:11-12). To support its genericness argument, Keating proffers the testimony of Dr. Eggleston, who, relying largely upon unauthenticated hearsay webpages and prescription orders that post-date April 2011 (or are undated), opines that the terms "Bruxzir" and "bruxer" are generic terms among dentists for all zirconia crowns. What Dr. Eggleston fails to address in his reports, his declarations, and his deposition is whether these terms were generic *as of April 2011*, the "crucial date" under Ninth Circuit law.

Dr. Eggleston's proposed testimony on issued related to genericness do not meet the requirements of Federal Rule of Evidence 702. Dr. Eggleston's testimony is not based on sufficient facts or data, because he relies on no facts or data probative of genericness as of the relevant time period. In addition, Dr. Eggleston's

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1 testimony is not the product of reliable principles and methods, because he relies
 2 almost entirely upon material (third party webpages) that lack authenticity, are
 3 hearsay, and are not probative of genericness as of the relevant time period. Even if
 4 he were permitted at trial to go beyond his expert reports and proffer opinions as to
 5 whether “bruxzir” or “bruxer” were generic terms for crowns as of April 2011 –
 6 and he should not be so permitted – he could not do so by reliably applying any
 7 sound principles and methods to the facts of the case. Instead, all he could do is
 8 speculate as to the state of affairs nearly two years ago based on undated or much
 9 more recent materials (i.e., third party webpages printed in the Fall of 2012). By
 10 definition, speculation is not reliable testimony.

11 Finally, Dr. Eggleston’s expert reports address only purported genericness of
 12 the BruxZir mark. They do not address other aspects of the parties’ claims or
 13 defenses, including whether there is a likelihood of confusion between BruxZir and
 14 KDZ Bruxer. Keating should not be permitted to do so at the time of trial.

15 II. STATEMENT OF FACTS

16 Keating retained Dr. Eggleston, a dentist in Newport Beach, as an expert
 17 witness to opine on the genericness of the terms “Bruxzir” and “bruxer” in the
 18 dental industry. (Dkt #93-1 [Expert Report of Dr. David W. Eggleston] at 1:4-6.)
 19 Not surprisingly, Dr. Eggleston opines that the terms “Bruxzir” and “bruxer” are
 20 indeed generic. (*Id.* at 12:1-9.) For example, Dr. Eggleston opines, among other
 21 things, that “[d]entists and other professionals in the dental industry refer to an all
 22 zirconia crown as a ‘bruxer crown’ or alternatively a ‘bruxzir crown.’” (*Id.* at 12:8-
 23 9.)

24 Dr. Eggleston claims that his opinion that the terms “Bruxzir” and “bruxer”
 25 are generic for all zirconia dental crowns is supported by “many materials that are
 26 found online, advertisements by Glidewell Laboratories, Keating Dental Arts, and
 27 other labs, as well as prescription orders that have been placed with dental labs.”
 28 (*Id.* at 16:15-18.) These materials were apparently provided to Dr. Eggleston by

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1 Keating's lawyers and attached to the first declaration Dr. Eggleston submitted in
 2 support of Keating's motions for summary judgment. (Dkt# 135 [Second
 3 Declaration of Dr. David Eggleston] at ¶2; Dkt# 93, Exs. 85-137.) All of the
 4 websites and prescription forms Dr. Eggleston relies upon¹ either post-date April
 5 2011² or are undated.³

6 In this action, Dr. Eggleston has submitted three expert reports (an initial
 7 report dated September 14, 2012, a rebuttal report dated October 12, 2012, and a
 8 first supplemental report dated October 12, 2012), two declarations (the first on
 9 November 19, 2012, and the second on December 3, 2012), and had his deposition
 10 taken on October 22, 2012. (Dkt## 93-1, 93-2, 93-3 and 135.) Nowhere in his
 11 reports, his declarations, or in his deposition does Dr. Eggleston offer an opinion
 12 regarding the genericness of the terms "Bruxzir" or "bruxer" as of April 2011. Nor
 13 does Dr. Eggleston offer an opinion regarding genericness as of May 10, 2011, the
 14 date Keating contends that it first sold crowns under the KDZ Bruxer mark.

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16 ¹ There are only two third party websites that Dr. Eggleston claims he relies upon
 17 to form his opinion that the terms "Bruxzir" and "bruxer" are generic for all
 18 zirconia dental crowns that purportedly pre-date April 2011. One is an
 19 unauthenticated hearsay posting on twitter.com from Pittman Dental Lab which
 20 purports to have been posted on November 29, 2010. (Dkt# 93, Ex. 120.) The
 21 other is an unauthenticated hearsay prescription order form from Mascola
 22 Esthetics in San Antonio, Texas which purports to be dated June 2010. (Dkt#
 23 93, Ex. 110.) Keating has not and cannot authenticate these webpages; i.e.,
 24 Keating cannot prove that the dates on these webpages accurately indicate when
 25 they were posted on the Internet. *See* Glidewell Motion In Limine No. 1 at II.

26 ² See Dkt. #195 at Trial Exhibits 22, 24, 28, 31, 75, 1008, 1010, 1178, 1451, 2081,
 27 2083, 2085, 2091, 2094, 2098, 2104, 2112-2115, 2167-2169.

28 ³ See Dkt #195 at Trial Exhibits 20, 67, 91, 560, 1000, 1001-1007, 1011-1018,
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 2117, 2122-2124, 2128-2130, 2170, 2172, 2203.

III. ARGUMENT

A. The Legal Standard.

Expert testimony is only admissible if it is both relevant (*i.e.*, will assist the trier of fact to understand the evidence or to determine a fact in issue) and reliable. Fed. R. Evid. 702; *Daubert*, 509 U.S. at 590. Under the Federal Rules of Evidence:

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:

(a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;

(b) the testimony is based on sufficient facts or data;

(c) the testimony is the product of reliable principles and methods; and

(d) the expert has reliably applied the principles and methods to the facts of the case.

Fed. R. Evid. 702.

This Rule imposes a “gatekeeper” role on the trial judge to ensure that unreliable testimony is excluded. *Daubert*, 509 U.S. at 589. Although *Daubert* sets forth several factors (peer review, publication, potential error rate, etc.) regarding reliability, they are not a definitive checklist or test. *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 150 (1999); *United States v. Prime*, 431 F.3d 1147, 1152 (9th Cir. 2005) (noting that the factors set forth in *Daubert* are not exhaustive).

Ultimately, “[t]he party offering the expert bears the burden of establishing that Rule 702 is satisfied.” *Sundance Image Tech., Inc. v. Cone Editions Press, Ltd.*, No. CV 02-2258 JM (AJB), 2007 WL 935703, *4 (S.D. Cal. Mar. 7, 2007).

1 citing *Allison v. McGhan Medical Corp.*, 184 F.3d 1300, 1306 (11th Cir.1999), in
 2 turn citing *Daubert*, 509 U.S. at 592 n. 10); *see also Walker v. Contra Costa*
 3 *County*, No. C 03–3723 TEH, 2006 WL 3371438, *1 (N.D. Cal. Nov. 21, 2006)
 4 (same, citing *Bourjaily v. United States*, 483 U.S. 171, 172 (1987), and *In re Paoli*
 5 *R.R. Yard PCB Litig.*, 35 F.3d 717, 744 (3d Cir.1994)).

6 Federal Rule of Evidence 403 also allows the trial court to exclude evidence
 7 when its “probative value is substantially outweighed by the danger of unfair
 8 prejudice, confusion of the issues, or misleading the jury.” Fed. R. Evid. 403;
 9 *United States v. Hankey*, 203 F.3d 1160, 1168 (9th Cir. 2000); *see also Viterbo v.*
 10 *Dow Chemical Co.*, 826 F.2d 420, 422 (5th Cir. 1987) (“lack of reliable support
 11 [for expert opinion] may render it more prejudicial than probative, making it
 12 inadmissible under Fed. R. Evid. 403”).

13 Similarly, Federal Rule of Evidence 703 prohibits experts from disclosing to
 14 the jury facts or data that are otherwise inadmissible “if their probative value in
 15 helping the jury evaluate the opinion substantially outweighs their prejudicial
 16 effect.” Fed. R. Evid. 703 advisory committee’s note (2000) (noting that there is a
 17 presumption against disclosure to the jury of inadmissible information used as the
 18 basis for expert’s opinion); *see also Turner v. Burlington N. Santa Fe R.R. Co.*, 338
 19 F.3d 1058, 1061 (9th Cir. 2003) (upholding the trial court’s exclusion of
 20 inadmissible hearsay used as the basis of opinion where the probative value was
 21 minimal and the prejudice from admission substantial under Rule 703).

22 **B. Dr. Eggleston’s Opinions Are Not Relevant.**

23 To be valid and protectable, a mark must be “distinctive.” *Zobmondo Enter.,*
 24 *LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010). “Distinctiveness
 25 measures ‘the primary significance of the mark to the purchasing public.’” *Id.*
 26 There are five categories of trademarks: (1) generic; (2) descriptive; (3) suggestive;
 27 (4) arbitrary; and (5) fanciful. *E.g., Yellow Cab Co. of Sacramento*, 419 F.3d at
 28 927. “The latter three categories are deemed inherently distinctive and are

1 automatically entitled to protection because they naturally ‘serve[] to identify a
 2 particular source of a product’” *Id.* (quoting *KP Permanent Make-Up, Inc. v.*
 3 *Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005)). A generic mark
 4 carries no protection, while a descriptive mark, although not inherently distinctive,
 5 can receive protection if it has acquired distinctiveness by establishing “secondary
 6 meaning” in the marketplace. *See id.*

7 “Marks that constitute a common descriptive name are referred to as generic.
 8 A generic term is one that refers to the genus of which the particular product is a
 9 species.” *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985).
 10 “To determine whether a term has become generic, we look to whether consumers
 11 understand the word to refer only to a particular producer’s goods or whether the
 12 consumer understands the word to refer to the goods themselves.” *Yellow Cab*,
 13 419 F.3d at 929 (citation omitted). If a buyer understands the term as being
 14 identified with a particular producer’s goods or services, it is not generic. *Id.* This
 15 so even if consumers do not know the identity of the source. *E.g., Maljack Prods.,*
 16 *Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) (mark may
 17 be distinctive even if source is anonymous).

18 “The *primary significance* of the registered mark to the relevant public ...
 19 shall be the test for determining whether the registered mark has become the
 20 generic name of goods or services on or in connection with which it has been used.”
 21 15 U.S.C. § 1064(3) (emphasis added); *Rudolph Int'l, Inc. v. Realys, Inc.*, 482 F.3d
 22 1195, 1198 (9th Cir. 2007), quoting *Filipino Yellow Pages, Inc. v. Asian Journal*
 23 *Publications, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (“[i]f the primary
 24 significance of the trademark is to describe the *type of product* rather than the
 25 *producer*, the trademark [is] a generic term and [cannot be] a valid trademark”)
 26 (emphasis in original). The test for genericness is not whether some portion of the
 27 relevant public views a term as generic, but whether the term’s primary significance
 28 to a *substantial majority* of the relevant public is as a generic term. *See King-Seely*

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1 *Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963); *Apple, Inc.*
 2 *v. Amazon.com Inc.*, C 11-1327 PJH, 2011 WL 2638191 (N.D. Cal. July 6, 2011)
 3 (“Put another way, generic terms are common names that a substantial majority of
 4 the relevant public understand primarily as describing the genus of goods or
 5 services at issue.”); *see also* 2 J. Thomas McCarthy, *McCarthy on Trademarks and*
 6 *Unfair Competition* § 12:6 (2012).

7 “The **crucial date** for the determination of genericness is the date on which
 8 the alleged infringer entered the market with the disputed mark or term.” *Yellow*
 9 *Cab Co. of Sacramento*, 419 F.3d at 928 (emphasis added); *see also* *Classic Foods*
 10 *Intern. Corp. v. Kettle Foods, Inc.*, 468 F. Supp. 2d 1181, 1188 n.10 (C.D. Cal.
 11 2007) (“The crucial date for the determination of genericness in this case is 1999,
 12 the date [the junior user] first entered the market with the disputed mark.”); *see also*
 13 *Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 164 F.3d 736, 744 (2nd. Cir.
 14 1998); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*
 15 § 12:17.50, p. 12-61 (2012) (“The Second and Ninth Circuits have held that the
 16 crucial date for the determination of genericness is the date on which the alleged
 17 infringer entered the market with the disputed mark or term.”)

18 Here, the crucial date for determining genericness is April 2011, the date
 19 Keating admits that it “adopted and began using” its KDZ Bruxer mark. (Dkt #67
 20 at 13:11-12; *see also* Dkt. # 95, ¶ 9 & Ex. F [March 31, 2011 announcement that
 21 Keating’s CAD/CAM family of products “now consists” of, among other products,
 22 KDZ Bruxer].) Keating has not disputed that the crucial date for determining
 23 genericness is the date that it entered the market using the “KDZ Bruxer” mark;
 24 Keating has merely disputed whether that crucial date was May 10, 2011 as
 25 opposed to April 2011. (Dkt. #141 at 9:8-10) Although the former may be the date
 26 that Keating first sold a KDZ Bruxer-brand crown, the pertinent question is when
 27 Keating “entered the market with the disputed mark.” *Yellow Cab*, 419 F.3d at 928.
 28 Here, by Keating’s own admission, that date is April 2011. (Dkt. #67 at 13:11-12.)

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1 **1. Dr. Eggleston Ignores the “Crucial Date” for Determining**
 2 **Genericness**

3 Dr. Eggleston does not opine as to whether the terms “Bruxzir” or “bruxer”
 4 were generic terms in the dental industry for all zirconia crowns as of the “crucial
 5 date” of April 2011. Nor could he. The vast majority of the materials that he relies
 6 upon either post-dated April 2011 or are undated. *See* footnotes 1-3, *supra*. Even
 7 putting aside its lack of reliability – addressed below – Eggleston’s testimony that
 8 BruxZir (or bruxer) are generic terms for zirconia crowns *now* does not “help the
 9 trier of fact to understand the evidence or to determine a fact in issue,” Fed. R.
 10 Evid. 702(a), given that the pertinent “fact in issue” is whether BruxZir was generic
 11 as of nearly two years ago. The proposed testimony is irrelevant and should be
 12 excluded under Rule 702.

13 In an effort to cobble together some reason why post-“crucial date” evidence
 14 of genericness is relevant, Keating has claimed, without any supporting authority,
 15 that evidence dated after the crucial date may nevertheless be relevant: (i) to
 16 “[e]stablish a comprehensive timeline of the use of the BruxZir name”...“to
 17 understand the status of BruxZir at the time of Keating’s entry”; and (ii) to
 18 “corroborate[] prior evidence.” (Dkt. #141 at 9:11-21.) These arguments make no
 19 sense in light of *Yellow Cab* or the evidence. Keating has developed *no* admissible
 20 evidence that BruxZir (or bruxer) was generic prior to April 2011. (Dkt #137 at
 21 II.A.3.) Accordingly, purported evidence of how “BruxZir” (or “bruxer”) may have
 22 come to be used *after* this “crucial date” cannot possibly “establish a
 23 comprehensive timeline” that includes April 2011 or earlier periods. Nor can such
 24 evidence “corroborate[] prior evidence,” given that there is nothing to corroborate.
 25 In any event, Dr. Eggleston does not opine as to the purported generic meaning of
 26 the term BruxZir “over time.” Instead, he opines on the use of the term as of the
 27 date of his expert report, prepared in September 2012, over a year and a half after
 28 the “crucial date.”

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At the summary judgment stage, Keating cited two cases from Georgia and Florida – *Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc.*, 2007 WL 4563873 (N.D. Ga. 2007) and *Burger King Corp. v. Pilgrim's Pride Corp.*, 705 F.Supp. 1522, 1525 (S.D. Fla. 1988) – indicating that surveys conducted after the alleged infringer entered the market could be probative of genericness, with the timing of the survey going to weight rather than admissibility. (Dkt. #141 at 9:11-10:4) But these district court opinions are not controlling and are inapposite here. Georgia and Florida are, of course, in the Eleventh Circuit rather than the Ninth Circuit. Neither case purports to apply the Ninth Circuit's *Yellow Cab* rule regarding the "crucial date" for determining genericness, and neither case articulates any basis for an exception to *Yellow Cab* here.⁴ In any event, Dr. Eggleston's reports are not surveys, and Dr. Eggleston does not purport to be a survey expert. The non-controlling survey cases from district courts in Georgia and Florida do not salvage Dr. Eggleston's irrelevant opinions.

2. Dr. Eggleston Does Not Opine on the Primary Significance of BruxZir (or bruxer) to a Majority of the Relevant Consumers

Dr. Eggleston's analysis is fatally flawed for another reason: he does not opine as to the *primary significance* of "BruxZir" (or "bruxer") to a *majority* of dentists, the relevant consumers, as of April 2011. Yet that is exactly what is required to determine genericness. The test for genericness is not whether some portion of the relevant public views a term as generic – or in Dr. Eggleston's case whether some undated or post-April 2011 dated internet material purportedly

⁴ The *Nightlight Systems* court, citing McCarthy, noted that "there are three possibilities for the critical date when genericness is to be tested: (1) the date when the proponent of the trademark rights first began the alleged trademark use, (2) just before the date when the accused infringer first entered the market, and (3) the current date of the litigation." 2007 WL 4563873, at *9. Citing *Burger King*, the *Nightlight* court elected the third option. *Id.* This is clearly contrary to the *Yellow Cab* rule – essentially, option two – applicable in the Ninth Circuit.

1 support his genericness conclusions – but whether the term’s primary significance
 2 to a *substantial majority* of the relevant public is as a generic term. *King-Seely*
 3 *Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 581 (2d Cir. 1963); *Apple,*
 4 *Inc. v. Amazon.com Inc.*, C 11-1327 PJH, 2011 WL 2638191 (N.D. Cal. July 6,
 5 2011) (“Put another way, generic terms are common names that a substantial
 6 majority of the relevant public understand primarily as describing the genus of
 7 goods or services at issue.”); *see also* 2 J. Thomas McCarthy, *McCarthy on*
 8 *Trademarks and Unfair Competition* § 12:6 (2012). Dr. Eggleston’s testimony
 9 should be excluded because he does not opine that, nor does he rely on anything
 10 that is probative of whether, the *primary significance* of “BruxZir” (or “bruxer”) to
 11 a majority of the relevant consumers is as a name for a genus of zirconia dental
 12 restoration products rather as an identifier of a single source of such products
 13 (which source may be unknown to consumers).

14 **C. Dr. Eggleston’s Opinions Are Not Reliable.**

15 Expert opinion must be reliable and be based on “sufficient facts or data.”
 16 Fed. R. Evid. 702. But here, not only does Dr. Eggleston, an expert hired to opine
 17 on genericness, fail to render an opinion as of the “crucial date” for determining
 18 genericness, he bases his opinion largely on post-April 2011 or undated,
 19 unauthenticated hearsay websites and prescription forms that were provided to him
 20 by Keating’s counsel. As discussed in detail in a companion motion *in limine* (See
 21 Glidewell Motion In Limine No. 1) the unauthenticated hearsay websites proffered
 22 by Keating should be excluded. So too should Dr. Eggleston’s opinions that are
 23 based on the excludable websites.

24 In *Ty Inc. v. Softbelly’s Inc.*, for example, plaintiff in a trademark
 25 infringement action sought to exclude defendant’s linguist expert who offered the
 26 opinion that the word “Beanie(s)” is generic.” *Ty Inc. v. Softbelly’s Inc.*, 00 C
 27 5230, 2006 WL 5111124 at *1 (N.D. Ill. Apr. 7, 2006). Defendant’s expert had
 28

1 reviewed “more than 14,000 pages of documents involving the results of Internet
 2 searches, copies of newspaper and magazine articles, legal proceedings, and the
 3 like, which also were provided by defense counsel,” but that focused on use of the
 4 term “Beanie” with products unrelated to the plaintiff. *Id.* at *2. The district court
 5 determined that “[q]uantity...does not establish quality, much less reliability.” *Id.*
 6 Reasoning that “[b]ecause [defendant’s expert] failed to demonstrate the reliability
 7 of the sources on which he relied for his opinion, [defendant’s expert] cannot
 8 establish the reliability of his opinion.” *Id.* at *3. The district court granted
 9 plaintiff’s motion and excluded the expert’s testimony. *Id.*; *see also Turner v.*
 10 *Burlington N. Santa Fe R.R. Co.*, 338 F.3d 1058, 1061 (9th Cir.2003) (upholding
 11 the trial court’s exclusion of inadmissible hearsay used as the basis of expert
 12 opinion where the probative value was minimal and the prejudice from admission
 13 substantial); *Viterbo v. Dow Chem. Co.*, 646 F. Supp. 1420, 1425 (E.D. Tex. 1986)
 14 aff’d, 826 F.2d 420 (5th Cir. 1987) (excluding expert testimony where opinion
 15 based on data that was “not sufficiently reliable, and lacks probative force, and
 16 therefore must be held inadmissible”); *see Sanderson v. Int’l Flavors &*
 17 *Fragrances, Inc.*, 950 F. Supp. 981, 1004 (C.D. Cal. 1996) (excluding expert
 18 testimony because proponent failed to show testimony was based on reliable
 19 sources).

20 The reliability of the materials upon which Dr. Eggleston relies is on far
 21 shakier ground than the supporting evidence that defendant’s expert relied upon in
 22 *Ty*. As detailed in Glidewell’s companion motion *in limine*, none of the internet
 23 material upon which Dr. Eggleston relies has been or can be properly authenticated,
 24 and it all constitutes inadmissible hearsay. *See* Glidewell Motion In Limine No. 1
 25 at II. Because Keating and Dr. Eggleston fail to demonstrate the reliability of the
 26 sources on which Dr. Eggleston relies for his opinion, Dr. Eggleston cannot
 27 establish the reliability of his opinion.
 28

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1 **D. The Probative Value of Dr. Eggleston's Testimony is Outweighed by Its**
 2 **Prejudicial Effect.**

3 Even if Dr. Eggleston's proposed testimony were at all probative of
 4 genericness as of April 2011 – which it is not – the testimony still should be
 5 excluded because “its probative value is substantially outweighed by a danger of ...
 6 unfair prejudice, confusing the issues, [and] misleading the jury.” Fed. R. Civ. P.
 7 403; *Monotype Corp. PLC v. Int'l Typeface Corp.*, 43 F.3d 443, 449 (9th Cir. 1994)
 8 (affirming district court's exclusion of evidence under Rule 403 because even if
 9 evidence was relevant, “it would be prejudicial and confuse the jury.”); *Lifshitz v.*
 10 *Walter Drake & Sons, Inc.*, 806 F.2d 1426, 1432 (9th Cir. 1986)(district court's
 11 exclusion of evidence proper where probative value of the evidence was
 12 outweighed by the considerable amount of time its admission would consume and
 13 the confusion it would cause the jury).

14 “Unfair prejudice” in the context of Rule 403 means an undue tendency to
 15 suggest decisions on an improper basis. Fed R. Evid. 403 ad. com. notes. Improper
 16 bases include unsupported inferences. *See United States v. Kaplan*, 490 F.3d 110,
 17 122 (2d Cir. 2007) (concluding that risk of unfair prejudice substantially
 18 outweighed probative value because the “jury was required to draw a series of
 19 inferences, unsupported by other evidence...”); *United States v. Ravich*, 421 F.2d
 20 1196, 1204 n.10 (2d Cir. 1970) (“The length of the chain of inferences necessary to
 21 connect the evidence with the ultimate fact to be proved necessarily lessens the
 22 probative value of the evidence, and may therefore render it more susceptible to
 23 exclusion as unduly confusing, prejudicial, or time-consuming ...”).

24 The Supreme Court recognized in *Daubert* the role of Rule 403 in
 25 determining the admissibility of expert testimony when it noted that expert
 26 testimony could be “both powerful and quite misleading because of the difficulty in
 27 evaluating it.” *Daubert*, 509 U.S. at 595; *see also Allison v. McGhan Med. Corp.*,
 28 184 F.3d 1300, 1301 (11th Cir. 1999).

1 Here, allowing the jury to hear Dr. Eggleston's opinions regarding the
 2 purported genericness of "BruxZir" (and "bruxer") *now*, and allowing Keating to
 3 argue that such evidence is probative of the terms' primary significance as of April
 4 2011 and earlier, poses a substantial risk of unfair prejudice and misleading of the
 5 jury. Simply put, the jury would be asked to, or inevitably misled to, determine
 6 genericness as of a time period other than the period that the Ninth Circuit has said
 7 is "crucial." It would do this by drawing unsupported inferences about the primary
 8 significance of "bruxzir" (or "bruxer") in April 2011 based on Dr. Eggleston's
 9 testimony about these terms' meaning in February 2013 (the time of trial). This is
 10 the epitome of unfair prejudice within the meaning of Rule 403.

11 Allowing the jury to hear Dr. Eggleston's opinions would also pose a
 12 substantial risk of confusing the issues. The jury very likely would be confused as
 13 whether it should determine genericness as of when Glidewell introduced the
 14 BruxZir mark, as of when Keating entered the market with KDZ Bruxer, as of when
 15 Eggleston formed his opinions, as of trial, or as of some combination or all of these
 16 periods. The jury also would likely be confused as to how evidence of a later
 17 period can "corroborate" non-existent evidence of an earlier period. Such
 18 confusion is particularly likely given that Keating has *no evidence* of genericness as
 19 of April 2011.

20 **E. The Court Should Preclude Dr. Eggleston From Rendering Any**
 21 **Opinions Not Included In His Expert Reports.**

22 Dr. Eggleston's opinions, as expressed in his reports, his declarations and his
 23 deposition, are exclusively devoted to the determination of genericness. (Trial
 24 Exhibits 2183 and 2187.) Dr. Eggleston does not offer an opinion regarding
 25 likelihood of confusion, and should not be allowed to do so at the time of trial. An
 26 expert opinion that is not disclosed in an expert report should be excluded from
 27 testimony at trial. *See Steinberg v. Sunbelt Transformer Co.*,
 28 CV0704226MMMAJWX, 2008 WL 5429587 (C.D. Cal. June 6, 2008) (limiting

1 expert testimony to opinions expressed in original report); *Colony Holdings, Inc. v.*
2 *Texaco Ref. & Mktg., Inc.*, SACV00217DOC(MLGX), 2001 WL 1398403 (C.D.
3 Cal. Oct. 29, 2001)(granting motion to exclude expert opinions after court limited
4 expert's testimony to provided report and materials).

5 **IV. CONCLUSION**

6 For the foregoing reasons, Glidewell respectfully requests that the Court
7 grant this Motion and issue an order (i) precluding Keating from introducing
8 testimony from its expert, Dr. David W. Eggleston, that the terms "Bruxzir" or
9 "bruxer" were or are generic terms for zirconia dental restoration products, and (ii)
10 precluding Keating from introducing opinion testimony from Dr. Eggleston,
11 including but not limited to opinions regarding the presence or absence of
12 likelihood of confusion between BruxZir and KZ Bruxer, beyond that which was
13 included in his expert reports.

14 Dated: January 17, 2013

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1 ***Glidewell Laboratories v. Keating Dental Arts, Inc.***
2 United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

3 **CERTIFICATE OF SERVICE**

4 I hereby certify that on January 17, 2013, I electronically filed the document
5 described as **JAMES R. GLIDEWELL DENTAL CERAMICS, INC.'S**
6 **NOTICE OF MOTION AND MOTION IN LIMINE #3 TO EXCLUDE THE**
7 **PROPOSED EXPERT TESTIMONY OF KEATING DENTAL ARTS, INC.'S**
8 **EXPERT DR. DAVID W. EGGLESTON; MEMORANDUM OF POINTS**
9 **AND AUTHORITIES** with the Clerk of the Court using the CM/ECF System
10 which will send notification of such filing to the following:

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